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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,563	12/19/2001	Kenneth W. Aull	15-0256	1021

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EXAMINER

BROWN, CHRISTOPHER J

ART UNIT PAPER NUMBER

2134

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,563

Applicant(s)

AULL ET AL.

Examiner

Christopher J. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/11/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/09/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The use of the trademark "DataCard 9000" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

It is noted that "DataCard 9000" and "identifiers, Meta tag, label tag, and command" are not mentioned in the specification. The examiner assumes that because these items are not mentioned, that they are obvious to one of ordinary skill in the art to implement.

Double Patenting

Applicant is advised that should claim 7 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two

claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 recites the limitation "the installing, first second and third writing, and the loading" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the identifiers" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 6, and 18 are objected to because of their use of the trademark, or trade name, DataCard 9000. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted

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on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 5, 9-13, 15-17, 19 21, 23, and 24 are rejected under 35

U.S.C. 102(e) as being anticipated by Gien US 2002/0112156.

As per claim 1, 5, 15, 16, 23, 24 Gien teaches that a hardware token is manufactured in a secure environment [0007], Gien teaches installing an operating system on a token, [0041]. Gien teaches creating a unique key encipherment certificate that comprises a public key for the token, [0190]. Gien teaches writing the unique key certificate onto the token, [0191]. Gien teaches writing a Root Certificate Authority certificate onto the token, [0011], [0031]. Gien teaches writing a unique private key that matches the unique key certificate, [0189]. Gien teaches writing a software package capable of validating future keys and decrypting keys, [0122].

As per claim 2, Gien teaches wiping contents of the token after receiving, [0071].

As per claim 3, Gien teaches that the integrity of the hardware token must be ensured during all the manufacturing phases, [0069].

As per claims 9, and 10; Gien teaches loading keys and certificates onto the hardware token encrypted, [0190], [0193].

As per claim 11, Gien teaches using the keys from the certificates issued by the Root Certificate Authority to validate new keys, [0011],[0122].

As per claim 12, Gien teaches a subscriber for requesting a token, [0028].

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As per claim 13, Gien teaches that the unique key encipherment certificate contains identification of the user, [0190].

As per claim 17, Gien teaches the hardware token is a smartcard, [0038].

As per claim 19, Gien teaches the processing center may be a certificate authority, [0011].

As per claim 21, Gien teaches the token is commercially available, [0008].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Deo US 5,721,781.

As per claim 4, Gein does not explicitly teach the smart card has a ROM.

Deo teaches a smartcard with a ROM capable of storing certificates, (Col 12 lines 6-15). It would have been obvious to one of ordinary skill in the art to use the ROM of Deo with the smart card of Gein because the smart card needs memory in order to store data.

Claims 6, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Kiekhaefer US 6,290,137.

As per claims 6, and 18 Gien does not teach use of the datacard 9000.

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Keikhaefer teaches that the datacard 9000 for encoding a hardware token, (Col 4 lines 56-59. It would have been obvious to one of ordinary skill in the art to use a datacard 9000 because it has multiple sensors to use while encoding.

Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Corella EP 117206A2

As per claims 7, and 8 Gien teaches using Certification Authorities to issue certificates. Gien does not teach storing certificates or public keys.

Corella teaches that a certificate authority maintains a database of public keys and associated certificates, (abstract).

It would have been obvious to one of ordinary skill in the art to use the database of Corella because the public keys are necessary for users to sign documents to send.

Claims 14, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gien in view of Corella EP 117206A2 in view of Boyles US 6,738,901

As per claims 14, 20, and 22, Gien as modified does not teach storing a set of public keys and certificates at the secure processing facility.

Corella teaches that a certificate authority maintains a database of public keys and associated certificates, (abstract).

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It would have been obvious to one of ordinary skill in the art to use the database of Corella because the public keys are necessary for users to sign documents to send.

Boyles teaches storing a serial number associated with a smart card, (Col 7 lines 45-55).

It would have been obvious to one of ordinary skill in the art to combine the serial number of Boyle with the previous Gien-Corella system because it allows easy identification of accounts related to the user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571)272-3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J. Brown

9/26/05



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